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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,071	11/05/2003	Yoshikazu Watanabe	826.1901	6314
21171	7590	08/24/2007		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER NAUROT TON, JOAN	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 08/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/701,071	Applicant(s) WATANABE ET AL.	
	Examiner Joan B. Naurot Ton	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/701,071.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/05/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

***This first office action is in response to Application 10/701071, filed on
11/05/2003.***

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 11-13 are rejected because the claimed invention is directed to non-statutory subject matter, in this case propagation signals. Regarding claims 11-13, which recite propagation signals, a propagation signal is in a non-statutory category.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5, 6, 8, 11, 9, and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Svensson (US Patent 5687216) in view of Kenjii (JP publication 10-070750, application 09-123926)

Regarding claims 1, 8, and 11:

Svensson discloses an electronic mail receiving method for use in a communications terminal having an electronic mail reception function, medium, terminal, and program causing the computer to execute (abstract): comprising making to a user a notification (Col 3, lines 40-45) that must be released (Col 4, lines 25-27) if a state where a new electronic mail cannot be captured (Col 1, lines 30-35) unless the of an existing electronic mail is released is determined, when the new electronic mail is received, or an inquiry is made to a mail server. (Col 6, lines 40-45). Svensson discloses all the limitations as disclosed above except for mail protection.

Kenjii discloses message protection. (paragraph 0005) . The general concept of providing mail protection is well known in the art as illustrated by Kenjii who discloses mail protection in an electronic mail receiving terminal, medium, method, and program.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Svensson to include the use of mail protection in his advantageous method as taught by Kenjii in order to retain important messages as stated by Kenjii in paragraph 0003.

Regarding claims 3, 9, and 12:

Svensson discloses the electronic mail receiving method, medium, terminal, and program causing the computer to execute further comprising making the user release the by transferring display contents to a after making the notification to the user. (Col 3, lines 41-45 and Col 4, lines 58-62 discloses notifying the user to release screen)

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Svensson discloses all the limitations as disclosed above except for protection and the protection release operation screen.

Kenjii discloses protection (paragraph 0005) and the protection release operation screen. (paragraph 0008). The general concept of providing a protection release screen and protection is well known in the art as illustrated by Kenjii who discloses a protection release screen and protection.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Svensson to include the use of protection release screen and protection in his advantageous method as taught by Kenjii in order to enhance mail receiving methods in a limited memory device.

Regarding claim 6:

Svensson discloses the communications terminal, comprising: a determining unit determining a state where a new electronic mail cannot be captured unless of an existing electronic mail is released, when the new electronic mail is received, or an inquiry is made to a mail server (Col 1, lines 30-34 imply a determining unit by the function that is disclosed.); and a guidance unit making to a user a notification that the must be released, if said determining unit determines the state where the new electronic mail cannot be captured unless the of an existing electronic mail is released. (Col 3, lines 42-45 imply a guidance unit by the function that is disclosed.) Svensson discloses all the limitations as disclosed above except for protection.

Kenjii discloses message protection. (paragraph 0005) . The general concept of providing mail protection is well known in the art as illustrated by Kenjii who discloses mail protection in an electronic mail receiving terminal, medium, method, and program.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Svensson to include the use of mail protection in his advantageous method as taught by Kenjii in order to retain important messages as stated by Kenjii in paragraph 0003.

Regarding claim 5:

Svensson discloses the electronic mail receiving method according to claim 1, wherein the state where a new electronic mail cannot be captured unless the of an existing electronic mail is released (Col 3, lines 40-46) is a state where a received electronic mail box is full and all of existing electronic mails (Col 1, lines 30-35 and (Col 3, lines 40-46). Svensson discloses all the limitations as disclosed above except for set to be protected and protection.

Kenjii discloses message protection. (paragraph 0005) and set to be protected (paragraph 0024). The general concept of providing mail protection is well known in the art as illustrated by Kenjii who discloses mail protection in an electronic mail receiving terminal, medium, method, and program.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Svensson to include the use of mail protection in his advantageous

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method as taught by Kenjii in order to retain important messages as stated by Kenjii in paragraph 0003.

4. Claims 2, 4, 7, 10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svensson and Kenjii in view of Makino (US application 09/046699)

Regarding claim 2, 7, 10, and 13:

Svensson discloses the electronic mail receiving method, medium, terminal, and program causing the computer to execute further comprising: electronic mails for which protection is to be released (Col 4, lines 25-27) so as to capture a new electronic mail and notifying the user and making the user release together for a plurality of existing electronic mails if the plurality of electronic mails is released, when the determination is made. (Col 6, lines 40-45) Svensson discloses all the limitations as disclosed above except for obtaining a minimum number of existing electronic mails for which protection is to be released, the obtained number mails for which protection is to be released.

Makino discloses obtaining a minimum number of existing mails for which protection is to be released so as to capture a new electronic mail (Col 2, lines 45-47, and Col 2, lines 65-67 and Col 3, lines 1-2 explains how obtaining a minimum number for which the user is notified of the number of messages to delete is accomplished. The general concept of obtaining a minimum number of existing mails for which protection is

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to be released so as to capture a new electronic mail is well known in the art as illustrated by Makino who discloses obtaining a minimum number of existing mails for which protection is to be released so as to capture a new electronic mail.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Svensson to include the use of obtaining a minimum number of existing mails for which protection is to be released so as to capture a new electronic mail in his advantageous method as taught by Makino in order to make room for new messages.

Regarding claim 4:

Svensson discloses the electronic mail receiving method according to claim 2, further comprising capturing a new electronic mail by making a deletion. (Col 1, lines 35-40)

Svensson discloses all the limitations as disclosed above except for deleting sequentially from an existing electronic mail having an older date among the existing electronic mails for which the protection has been released.

Kenjii discloses deleting sequentially from an existing electronic mail having an older date among the existing electronic mails for which the protection has been released. (paragraph 0024, discloses how unprotected messages are deleted

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sequentially which may have been formerly protected, while protected messages are saved.)

The general concept of deleting sequentially from an existing electronic mail having an older date among the existing electronic mails for which the protection has been released is well known in the art as illustrated by Kenjii who discloses deleting sequentially older messages in a system which releases protection of messages.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Svensson to include the use of deleting sequentially from an existing electronic mail having an older date among the existing electronic mails for which the protection has been released in his advantageous method as taught by Kenjii in order to make room for new messages.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joan B. Naurot Ton whose telephone number is 571-270-1595. The examiner can normally be reached on M-Th 9 to 6:30 (flex sched) and alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBNT
8/20/2007


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